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EXAMINER

CHAMPAGNE, DONALD

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 8

Application Number: 09/439,718
Filing Date: November 12, 1999
Appellant(s): ENRIGHT, JEFFERY M.

Ralph E. Jonke
For Appellant

MAILED

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GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 September 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant does not explain why the claims of the group are believed to be separately patentable. Appellant merely points out differences in what the claims cover, which is not an acceptable argument as to why the claims are separately patentable (37 CFR 1.192(c)(7)).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,859,416	Gatto	1-1999
6,193,154 B1	Phillips et al.	2-2001

(10) Grounds of Rejection

The following ground(s) of rejection, copied verbatim from the final rejection (Paper No. 5 filed 8 May 2002), are applicable to the appealed claims. Paragraph numbers correspond to those in the rejection, as referred to by appellant.

1. Applicant's arguments filed 7 March 2002 (Paper No. 4) have been fully considered but they are not persuasive. A detailed explanation is given with the following final rejection.
5. Claims 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al. Phillips et al. teaches (independent claim 38): a) accepting an amount of cash for the merchandise (col. 27 lines 22-39); b) generating a code for the amount of change (col. 3 lines 13-22); c) outputting the code on a receipt and d) paying a second charge by inputting the code (col. 3 lines 41-42). The receipt reads on indicia representative of the code (claim 39).
6. Claims 1-37 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. in view of Gatto.
7. Phillips et al. teaches (independent method claims 1 and 40, and apparatus dependent claim 27) a method and apparatus, the method comprising: a) paying a charge for motor fuel first goods (merchandise) delivered to a user at a self-service dispensing machine, including reading a credit card (col. 1 line 12 and col. 3 lines 38-39); b) receiving an input from the user through an input device adjacent the dispensing machine, wherein the input corresponds to a request for a second good, and c) charging the credit card for the charge and the second good (col. 3 lines 39-40); d) outputting a receipt usable for dispensing the second good from the seconds good dispensing apparatus (col. 3 lines 41-42), which reads on communicating information representative of the request for the second good to a facility including a supply for the second good, and e) delivering the second good from the supply after the user arrives at the facility.
8. Phillips et al. does not teach that the facility is remote from the machine. However, Phillips et al. does teach (col. 2 lines 42-54) that is desirable to attract customers into a mini-market at the vehicle fueling facility, which reads on a facility remote from the

- machine. Because of this suggestion to improve sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to place the second goods in the mini-market facility remote from the machine.
9. Applicant argues (p. 8) that Phillips et al. does not teach or suggest locating the vending machine inside of the mini-market. That is correct, but irrelevant. Phillips et al. has been cited for its identification of a problem and its suggestion of a solution, but not for the solution that it provides. Phillips does teach (at col. 2 lines 42-54, which was erroneously labeled col. 3 in the first Office action, but correctly marked in the reference copy provided to applicant) that is desirable to attract customers into the mini-market. The reference notes in particular (col. 2 lines 50-54) that the use of credit cards has exacerbated the problem of getting the consumer into the mini-market so as to increase sales to the consumer.
10. As a solution, Phillips et al. teaches a vending machine located on the fuel pump island. That can be expected to increase sales, but it is hardly a perfect solution to the problem identified by Phillips et al. That solution has the obvious disadvantage of limiting sales to some small fraction of the goods available in the mini-market. Examiner is arguing that, for this reason, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use the mini-market itself as the venue for retailing the second goods.
11. Applicant has given reasons (beginning at the last para. on p. 8) why the solution of Phillips et al. would be preferred over encouraging the customer to enter the mini-market to purchase second goods. Some of these reasons do have merit, e.g., customers with small children probably would prefer the convenience of second goods available at the island, assuming of course that the second goods offered are what the customer wants. But the advantage of being able to present to the customer the entire selection of goods available in the mini-market is great enough to make it an obvious preference over the Phillips et al. solution, locating a vending machine on the fuel pump island.
12. Applicant argues (beginning at the second para. of p. 9) that Gatto et al. is limited to transactions adjacent the fuel pump; not concerned with a facility remote from the fuel pump; and not concerned with delivering a requested amount of cash. As noted

in the following rejection paragraph, the reference teaches “pay inside” and “cash back”, which reads on transactions remote from the fuel pump and concerned with delivering a requested amount of cash.

13. Phillips et al. does not teach that the second good is an amount of cash. Gatto teaches a second good that is an amount of cash (col. 1 line 30 and col. 6 lines 25-26). Because dispensing cash could be expected to increase store traffic and therefore sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to dispense cash-back in the mini-market facility remote from the machine.
14. Phillips et al. does not teach (claim 40) a cash-dispensing device remote from the customer request station. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Gatto (col. 1 line 30 and col. 6 lines 25-26) does teach “pay inside” and “cash back”, which at very least requires a cash register in the mini-market, and that reads on a cash-dispensing device remote from the customer request station.
15. At the reference points given above, Phillips et al. does teach claims 2, 3, 12, 13, 20, 22-24 and 41.
16. Applicant argues (middle of p. 11) that Phillips et al. does not teach claim 3. The reference teaches a mini-market (col. 2 line 47), which reads on the claim.
17. Phillips et al. also teaches: (claims 4-6, 18, 19, 28-32 and 37) that the receipt is printed with a bar code (col. 9 lines 38-58) and (claims 7 and 8) the receipt reader (col. 9 line 28-37) is operatively connected to the second goods dispenser, which inherently would have to be loaded from a larger supply; (claims 9 and 21) displays for prompting a customer (col. 5 lines 53-60); and (claims 10 and 11) conventional credit-card accounting mechanisms (col. 2 lines 2-10).
18. Phillips et al. does not teach (claims 14-17 and 33-35) a debit or stored value cards, and receiving a further input corresponding to the user. Gatto teaches debit and stored value cards (col. 3 lines 26 and 44-45). Because these cards facilitate sales,

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it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add this teaching of Gatto to those of Phillips et al. Gatto also teaches receiving a further input corresponding to the user (col. 4 lines 8-12 and 34-37). Because this further input is solicited to either enhance security or elucidate user preference, either of which can be expected to enhance the business, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to also add this teaching of Gatto to those of Phillips et al.

19. Neither of the references teach (claims 25, 26 and 36) that the facility includes a service window and that the further input corresponds to a feature of the user's vehicle. Official notice is taken (MPEP § 2144.03) that these limitations were common, at the time of the instant invention. A drive-up service window would be especially attractive as a customer convenience feature at a facility dispensing motor fuel and small items such as cash. "Speed passes" and similar vehicular identifiers also provide the customer with obvious convenience, and therefore support the business.
20. Neither of the references teach (claims 42 and 43) a self-service automated cash-dispensing device (ATM) remote from the customer request station. However, Gatto does teach a plurality of self-service automated cash dispensing devices *10* also comprising the customer request station (col. 6 lines 20-26), implicitly to be located at or near the fuel pump (col. 4 lines 59-63), and which function as an ATM (col. 6 line 5). Because it would provide security commonly provided for ATMs and for mini-markets, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to place one of the devices *10* inside the mini-market, which reads on remote from the customer request station.

(11) Response to Argument

For independent claim 38, the crux of appellant's argument is in the first paragraph on p. 8: Appellant argues that Phillips et al. does not teach "'generating a code' which corresponds to a difference between a merchandise charge and an amount of cash

accepted" (underline added). It is true that the example embodiment does not teach this limitation, but the reference is available for all it teaches, not merely for its examples.¹

The teaching of a difference between a merchandise charge and an amount of cash accepted is inherent through the teaching of options. The reference teaches a generic *first goods dispensing apparatus* and a generic *second goods dispensing apparatus* (col. 5 lines 31-32). For the sake of illustration, the reference subsequently describes the first apparatus as a *self-service fuel-dispensing pump 1* (col. 5 lines 33-34), and describes the second apparatus as a *vending machine 3* (col. 6 lines 36-37). The use of "for example" at col. 5, line 33 makes it clear that these specifications are for illustration, and not intended to limit the reference invention.

The reference teaches that one of these apparatuses can optionally accept cash ("paper money", col. 6 lines 47-55), and that one of these apparatuses can have a *printer 13* to generate a *receipt 45A* bearing the code that can be input to purchase from the other apparatus (col. 9 lines 8-17), which reads on a code which corresponds to a difference between a merchandise charge and an amount of cash accepted.

The reference teaches (col. 9 lines 16-19) that this code allows the second purchase without the need for cash (coin or paper money). This again is in the context of the example embodiment, where the joint purchase is made with a credit card. Yet one of ordinary skill in the art would know that many people prefer not to use credit cards. The invention would for these customers be just as advantageous if it took a ten dollar bill for the joint purchase.

Concerning independent claims 1 and 40 (and apparatus claim 27) rejected under 35 USC 103, appellant alleges (beginning at the bottom of p. 9) that the rejections are based only on hindsight and lack motivation to combine.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

¹ The example embodiment teaches generating a code which corresponds to a difference between a merchandise charge and an amount debited on a credit card (col. 3 lines 14-19).

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knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The rejections, at para. 8, 13 and 14 in (10) above, meet this test and are therefore appropriate.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The rejections, at para. 8, 13 and 14 in (10) above, contain appropriate and adequate suggestions to combine the references.

Appellant argues in detail against the rejection of independent claim 1 (pp. 11-18) by focusing only on the example embodiment of Philips et al. Indeed, appellant's quotations are highly selective. At the bottom of p. 11, appellant argues that "Phillips' second goods dispensing apparatus is associated with a vending machine (3) for vending canned drinks (col. 3, lines 1-7)." In fact, the reference says the following (col. 3, lines 3-4), where parts omitted by appellant are underlined: "a second good dispensing apparatus 3, such as a vending machine 3 for vending canned drinks for example". The reference teaching is broader than acknowledged by appellant.

A key issue is the instant invention limitation "to a facility remote from the machine" (part "d)" of claim 1). Appellant on pp. 11-14 has repeated arguments that were addressed in the final rejection; the rejection and examiner's reply is given here as para. 8-12 in (10) above.

Both claims 1 and 40 are limited to "a request for an amount of cash". That limitation is rejected at para. 8-12 in (10) above. Key to the rejection is the teaching of "pay inside" and "cash back" in the secondary reference, Gatto (col. 1 line 30 and col. 6 lines 25-26). Appellant argues on p. 15 that the meaning of these terms is not clear. These are common terms whose meaning is clear to lay people as well as to those of ordinary skill in the retailing art. Furthermore, "pay inside" necessarily requires not only a mini-market or kiosk with the fuel pumps, but requires a cash register therein. Appellant argues

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otherwise on p. 16, but provides no basis for denying the plain meaning of these terms. Pages 17-18 and pp. 29-32 for claim 40 repeat arguments made previously by appellant.

The dependent claim rejections are given at para. 15-20 inclusive in (10) above.

Twenty-seven of these dependent claims have additional limitations that are expressly taught by the references (para. 15-17). The remaining 11 claims have additional limitations that are obvious over the references (para. 18-20). Appellant alleges (pp.18-29 and 32-33) that these rejections are flawed, but fails to address the rejections. This is a tacit admission that the dependent claims add only known or obvious limitations, and should therefore stand or fall with the independent claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner

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23 October 2002



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